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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

J&J Reference No. **DEP 486**

MMB Docket No. **1671-0099**

In re patent application of: **Lester et al.**

Serial No. **09/678,032**

Filing Date: **October 3, 2000**

Examiner: **C. Prone**

Group Art Unit: **3738**

**For: Acetabular Cup and Reamer Assembly and Associated
Method for Securing the Cup to an Acetabulum**

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Name of person mailing Document or Fee

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Sir:

Enclosed please find an original Reply Brief in connection with the above-identified patent application. The Answer Brief was mailed on June 6, 2005 and the Reply Brief was due two months from this date (i.e. 8/6/05). Since the due date of filing

the Reply Brief fell on Saturday, August 6, 2005, the Reply Brief is being timely filed on Monday, August 6, 2005.

Please provide any extensions of time which may be necessary and charge any fees which may be due to Account No. 13-0014, but not to include any payment of issue fees.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "James D. Wood", written over the typed name.

James D. Wood
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August 8, 2005
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August 8, 2005

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REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed on June 6, 2005, Appellants
hereby reply pursuant to 37 CFR § 1.193. Note that this reply is being timely

filed on Monday, August 8, 2005 since the two month due date of August 6, 2005 fell on a Saturday. Please provide any extensions of time that may be necessary and charge any fees that may be due to Account No. 13-0014, but not to include any payment of issue fees.

For reasons set forth more fully below, the Examiner has failed to establish that independent claims 31 and 38 are anticipated under 35 U.S.C. § 102.

Claim 38 Requires Mismatching of Physical Configuration of Cavity and Cup

The Examiner's Answer states on page 4, lines 4-7 that:

"claim 38 does not require the mismatching of sizes of the cavity and the cup. Claim 38 requires the semi-hemispherical size of the cup, as addressed above, but fails to require that the cavity be 1 or 2 millimeters less than the cup."

This statement exposes the Examiner's misunderstanding of claim 38, as well as claim 31. Although the reamed cavity defined by claim 38 is not recited as being less than hemispherical but rather is recited as being precisely "hemispherically-shaped", the Examiner mischaracterizes the size (or more accurately the *physical configuration*) of the claimed cup. Significantly, the claimed cup does not possess a true hemispherical shape, but rather it is 0.5 mm to 2.0 mm less than a true hemispherical shape.¹ Thus, in claim 38, the physical configuration of the cup (less than hemispherical) is mismatched in

¹ For clarity of discussion, Appellants are using the descriptive phrase "0.5 mm to 2.0 mm less than a true hemispherical shape" as describing of the actual language of claim 38 that defines the shape/configuration of the claimed acetabular cup.

relation to the physical configuration of the reamed cavity (hemispherical). This mismatching feature provides significant advantages when press fitting an acetabular cup into a reamed cavity.

Again, claim 38 requires press fitting a cup (that possesses a less than true hemispherical shape or physical configuration) into a precisely hemispherically-shaped cavity reamed in an acetabulum. Thus, when a precisely hemispherically-shaped reamed cavity receives in a press fit manner a slightly larger radiused cup², much force will be exerted on the walls defining the cavity in the acetabulum by the now compressed cup. This relatively high force enhances bone ingrowth of the cavity wall of the acetabulum into the outer surface of the cup. When this slightly larger radiused cup is *0.5 mm to 2.0 mm less than a true hemispherical shape as claimed*, its rim portion will not protrude out of the reamed cavity because of the less than hemispherical shape or configuration of the cup. This advantageously allows the upper rim of the cup to lie substantially flush with the surface of the acetabulum that surrounds the reamed cavity after the cup is press fit in the reamed cavity.

As discussed in Appellants' Appeal Brief (see page 5, line 15 through page 6, last line, and page 7, line 20 through page 8, line 6) *Amstutz does not disclose mismatching the physical configurations of the cavity (hemispherical) and the cup (less than hemispherical)*. It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Amstutz does not disclose each and every

² That is, the radius of the cup is slightly larger than the radius of the reamed cavity.

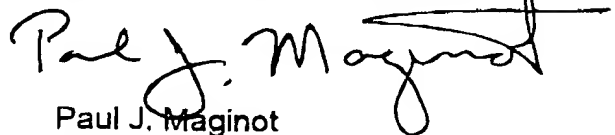
element of Appellants' claim 38 (and claim 31), Amstutz does not anticipate claim 38 (and claim 31).

CONCLUSION

The Examiner has failed to establish that independent claim 38 (and claim 31) are anticipated under 35 U.S.C. § 102, and thus the rejection of claims 31-44 should be overruled and the claims allowed.

Respectfully submitted,

MAGINOT, MOORE & BECK

A handwritten signature in black ink, reading "Paul J. Maginot". The signature is written in a cursive style with a long horizontal line extending from the end of the name.

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August 8, 2005

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